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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/800,314 | 03/06/2001 | Peter V. Radatti | 17-00 | 2982 |

| | |
|---|---|
| 7590      02/16/2007 | EXAMINER |
| CyberSoft, Inc. | REVAK, CHRISTOPHER A |
| 1508 Butler Pike | |
| Conshohocken, PA 19428-1322 | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2131 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 02/16/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/800,314 | RADATTI ET AL. |
| | Examiner | Art Unit | |
| | Christopher A. Revak | 2131 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>26 December 2006</u>.

2a) ☐ This action is **FINAL.**      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1-13</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>06 March 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1.      A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection.  Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114.  Applicant's submission filed on October

30, 2006 has been entered.

### *Response to Arguments*

2.      Applicant's arguments filed have been fully considered but they are not

persuasive.  It is argued by the applicant that it is not taught of "the proscribed code

scanner reviewing information pre-existing in the code prior to the code being

intercepted and processed by the apparatus".

The examiner disagrees with the applicant's assertion.  The teachings of Ranger

are relied upon for disclosing the proscribed code scanner reviews information pre-

existing in the code prior to the code being intercepted and processed by the apparatus,

see column 3, lines 30-41 & 47-54.  The pre-existing content, or original data, is

encrypted and packaged for transmission.  The pre-existing data, or original data, is

scanned by the proscribed scanner, or virus scanner, for malicious content.  The data is

never altered or changed in light of the teachings of Ranger, it is first decrypted in order

to scan the content for viruses.  The original data that is encrypted and decrypted

always pre-exists, the appearance is altered through use of encryption and decryption

functions according to the teachings of Ranger.

3.      The applicant has indicated that if the examiner maintains the nonstatutory

obviousness-type double patenting rejection, a terminal disclaimer would be filed.  The

examiner is maintaining the obviousness-type double patenting rejection.


### *Double Patenting*

4.      The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.  A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s).  See, e.g., In re Berg, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ
644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a
        terminal disclaimer.  A terminal disclaimer signed by the assignee must fully comply
        with 37 CFR 3.73(b).

5.      Claims 1-13 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 4-17 of

copending Application No. 09/800,328.  Although the conflicting claims are not identical,

they are not patentably distinct from each other because claims 1-14 of the instant

application are envisioned by copending Application No. 09/800,328 in that claims 4-17

of the copending application contain all the limitations of claims 1-14 of the instant

application. Claims 1-14 of the instant application therefore is not patentably distinct

from the copending application, and as such, is unpatentable for obvious-type double

patenting.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

6.      Claims 1-13 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over 1-36 of copending

Application No. 10/655,387. Although the conflicting claims are not identical, they are

not patentably distinct from each other because claims 1-14 of the instant application

are envisioned by copending Application No. 10/655,387 in that claims 1-36 of the

copending application contain all the limitations of claims 1-14 of the instant application.

Claims 1-14 of the instant application therefore is not patentably distinct from the

copending application, and as such, is unpatentable for obvious-type double patenting.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

7.      Claims 1-13 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-12 of

copending Application No. 09/838,979. Although the conflicting claims are not identical,

they are not patentably distinct from each other because claims 1-14 of the instant

application are envisioned by copending Application No. 09/838,979 in that claims 1-12

of the copending application contain all the limitations of claims 1-14 of the instant

application. Claims 1-14 of the instant application therefore is not patentably distinct

from the copending application, and as such, is unpatentable for obvious-type double

patenting.

This is a _provisional_ obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

### Claim Rejections - 35 USC § 103

8.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.      Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hawe et al, U.S. Patent 5,070,528 in view of Ranger et al, U.S. Patent 6,393,568.

As per claim 1, it is taught by Howe et al of an apparatus and method for

intercepting and processing code on a communications channel. The protocol is parsed

(by means of a protocol parser) and then transferred to be decrypted (by means of a

decryption component)(col. 10, lines 38-44 and col. 10, line 63 through col. 11, line 1)

and it is interpreted by the examiner that the code is intercepted by the protocol parsing

means as it is transmitted through the communication channel since it is disclosed by

Hawe et al that the basic step of identifying the protocol (by means of a protocol

scanner) used to generate the packets determines which type of encryption is needed
(col. 10, lines 38-44). The teachings of Hawe et al fail to disclose of a proscribed code
scanner that scans the decrypted code and that the scanner reintroduces to the
communication channel all, some, or none of the intercepted code. It is disclosed by
Ranger et al that encrypted information is decrypted prior to scanning by a content
inspection mechanism (proscribed code scanner)(col. 2, lines 40-43 & 58-61). Ranger
et al teaches of indicating the presence of the proscribed code if the indicator is positive
(col. 6, lines 32-43). The proscribed code scanner reviews information pre-existing in
the code prior to the code being intercepted and processed by the apparatus (col. 3,
lines 30-41 & 47-54). The scanner reintroduces to the communication channel all,
some, or none of the intercepted code (col. 4, lines 38-50 and col. 6, lines 24-28 & 32-
43). It would have been obvious to a person of ordinary skill in the art at the time of the
invention to have been motivated to apply decryption prior to scanning for viruses.
Ranger et al discloses motivational benefits by decrypting code prior to scanning for
viruses by reciting by discussing a need for detecting viruses in communications
received in encrypted form such that it would provide virus detection in real time for a
communication system (col. 1, lines 58-64) and virus programs are not able to decrypt
encrypted information (col. 1, lines 21-23). It would have been obvious that the
teachings of Hawe et al would have found the teachings of Ranger et al beneficial as a
means of efficiently scanning encrypted files for viruses by decrypting the files prior to
scanning for viruses to provide real time content inspection for viruses.

As per claims 2 and 3, Hawe et al discloses of intercepting code prior to decrypting the encrypted code (col. 10, lines 38-44). It is interpreted by the examiner that the secure/altered code is intercepted by the protocol parsing means in as it is transmitted through the communication channel since it is disclosed by Hawe et al that the basic step of identifying the protocol (by means of a protocol scanner) used to generate the packets determines which type of encryption is needed (col. 10, lines 38-44). Ranger et al is relied upon for disclosing that encrypted information is decrypted prior to scanning by a content inspection mechanism (proscribed code scanner in a separate system)(col. 2, lines 40-43 & 58-61). The presence of the proscribed code is indicated if the indicator is positive (by means of an indicator)(col. 6, lines 32-43). Please refer above for the motivational benefits of the teachings of Ranger et al as applied to Hawe et al.

As per claims 4 and 13, Ranger et al teaches of scanning the code for the presence of proscribed code further comprising scanning the code for the presence of viruses (col. 6, lines 32-43).

As per claims 5,6, and 11, it is interpreted by the examiner that the code is configured for interception parameters by the protocol parsing means in as it is transmitted through the communication channel since it is disclosed by Hawe et al that the basic step of identifying the protocol (by means of a protocol scanner preconfigured) used to generate the packets determines which type of encryption is needed (col. 10, lines 38-44).

As per claims 7 and 8, it is taught by Howe et al of an apparatus and method for intercepting and processing code on a communications channel. The protocol is parsed (by means of a protocol parser) and then transferred to be decrypted (by means of a decryption component)(col. 10, lines 38-44 and col. 10, line 63 through col. 11, line 1) and it is interpreted by the examiner that the code is intercepted by the protocol parsing means as it is transmitted through the communication channel since it is disclosed by Hawe et al that the basic step of identifying the protocol (by means of a protocol scanner) used to generate the packets determines which type of encryption is needed (col. 10, lines 38-44). The teachings of Hawe et al fail to disclose of a proscribed code scanner that scans the decrypted code. It is disclosed by Ranger et al that encrypted information is decrypted prior to scanning by a content inspection mechanism (proscribed code scanner)(col. 2, lines 40-43 & 58-61). Ranger et al teaches of indicating the presence of the proscribed code if the indicator is positive (col. 6, lines 32-43). The proscribed code scanner reviews information pre-existing in the code prior to the code being intercepted and processed by the apparatus (col. 3, lines 30-41 & 47-54). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply decryption prior to scanning for viruses. Ranger et al discloses motivational benefits by decrypting code prior to scanning for viruses by reciting by discussing a need for detecting viruses in communications received in encrypted form such that it would provide virus detection in real time for a communication system (col. 1, lines 58-64) and virus programs are not able to decrypt encrypted information (col. 1, lines 21-23). It would have been obvious that the

teachings of Hawe et al would have found the teachings of Ranger et al beneficial as a

means of efficiently scanning encrypted files for viruses by decrypting the files prior to   •

scanning for viruses to provide real time content inspection for viruses.

As per claim 9, Ranger et al discloses of re-encrypting (returning) code if it is fully

trusted (indicator is negative)(col. 7, lines 20-27). Please refer above for the

motivational benefits of the teachings of Ranger et al as applied to Hawe et al.

As per claim 10, Ranger et al teaches of indicating the presence of the

proscribed code if the indicator is positive (col. 6, lines 32-43). Please refer above for

the motivational benefits of the teachings of Ranger et al as applied to Hawe et al.

As per claim 12, Hawe et al discloses of intercepting code prior to decrypting the

encrypted code (col. 10, lines 38-44). Ranger et al is relied upon for disclosing that

encrypted information is decrypted prior to scanning by a content inspection mechanism

(proscribed code scanner in a separate system)(col. 2, lines 40-43 & 58-61). The

presence of the proscribed code is indicated if the indicator is positive occurring on a

separate machine (col. 6, lines 32-43). Please refer above for the motivational benefits

of the teachings of Ranger et al as applied to Hawe et al.


### Conclusion

10.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christopher A. Revak whose telephone number is 571-

272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CR
February 14, 2007

CHRISTOPHER REVAK
PRIMARY EXAMINER